

"ragged edges...having been created by a tearing action"

Applicant's suggested new claim language:

"ragged, torn edges"

There is no difference between these claim limitations. Both recite a characteristic of the "torn edges". The new (and equivalent) claim language is found in the original specification, *inter alia*, as follows (emphasis supplied):

"Fig. 2 is a perspective view of the novel patterned torn or ragged open cell sponge in a conventional paint roller configuration" (page 2, ll. 22-23).

"Fig. 6 is a side elevational view of the novel torn patterned open cell synthetic sponge roller configured in a corner roller embodiment" (page 2, ll. 31-32)

"When the synthetic sponge material is composed of an open cell elastomeric material, the torn edges of the open cells are quite similar in structure to natural sea sponges." (page 3, ll. 11-13)

"In this regard, the shape or type of pattern is not critical since it is the creation of torn edges that is desired. For present purposes, then, the pattern can be random or predefined, as the creation of torn edges of the open cell foam elastomer is the effect desired." (page 3, ll. 14-17)

"It will be observed, then, that the uniqueness of the inventive torn-patterned sponge rollers have properties that can be translated to other foam rollers that are not sponge-like in nature." (page 4, ll. 3-5)

"Nevertheless, one preferred configuration of the novel torn patterned open cell synthetic sponge is in such elongate paint roller configuration. There are, however, a variety of other useful configurations for the novel torn patterned open cell synthetic sponge as those skilled in the art will appreciate based on the instant disclosure. (page 4, ll. 20-24)

Applicant could continue to recite numerous other instances where the "edges" are defined as being "torn". It also is true that the "torn edges" are "created by a tearing action", as can be found in the original specification, *inter alia*, as follows:

"The key to mimicking natural sea sponges is not to orderly remove the material by a cutting action that would create smooth edges; but rather, to remove material by a tearing action to create ragged edges. Such ragged edges created by a tearing action yield a natural sponge-like affect when used in creating faux or rag paint finishes. In order to obtain such a tearing action, the manufacturer should avoid using sharp edged rotating cutting elements such as router bits. Rather, the manufacturer should use a simple grinding wheel that grabs the synthetic sponge material and thereby tears it. That is not to say that some "cutting" of the material does not happen, as it does. However, many of the edges are torn away by the grinding wheel. (page 3, ll. 3-10).

"Rather, it has been unexpectedly discovered that the elastomeric material should be removed by a tearing action to leave torn or ragged edges where the elastomeric material has been removed." (page 5, ll 6-8).

Again, numerous additional instances in the application can be found a support for such equivalence of language and expression. Applicant has the right to define the invention by "claiming the subject matter which the applicant regards as his invention." (35 U.S.C. § 112). Applicant has done so without ambiguity. The original expression and the new claim language are equivalent and are amply supported in the original specification and drawings. No new matter is added by these amendments and their entry respectfully is requested.

No new matter is added by virtue of the claim amendments. Moreover, such claim amendments are ministerial in nature as they relate to the formalistic structure and form of the claim language, which was seen to be clear and unambiguous by Applicant. Accordingly, Applicants assert that no claims have been narrowed with the meaning of *Festo* (*Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 56 USPQ2d 1865 (Fed. Cir. Nov. 29, 2000)).

With respect to claim 21, the Examiner criticized claim 21 as not calling for the pair of sponges to surmount the same core. The second line of claim 21 calls for "an interior annular core". The clear use of the single "an" contradicts the Examiner's observation that the heads can be mounted on two different cores. Such interpretation also contradicts Fig. 5 and its description at page 7, ll. 3-12. Nevertheless, in order to dispel any lingering doubts on this subject, claim 21 was amended to clarify such meaning by adding the

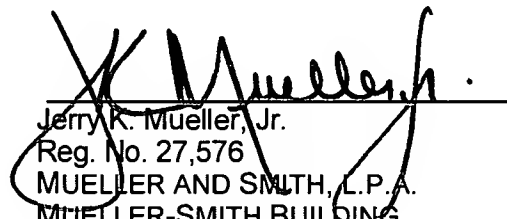
expression "wherein said sponges are spaced-apart on said core" (the added language being underlined here).

Again, no new matter is added by virtue of the claim amendments. Moreover, such claim amendments are ministerial in nature as they relate to the formalistic structure and form of the claim language, which was seen to be clear and unambiguous by Applicant. Accordingly, Applicants assert that no claims have been narrowed with the meaning of *Festo* (*Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 56 USPQ2d 1865 (Fed. Cir. Nov. 29, 2000)).

While the application describes the invention accurately and completely, perhaps, prosecution can be materially advanced by the Examiner viewing one of the novel torn, patterned sponges and comparing it to the same patterned open cell sponge roller without such torn edges. Accordingly, enclosed with this paper are two rollers, one with torn edges and one without. Also, the results of rolling paint onto paper with these rollers are enclosed. The totally unique pattern created on the roller with torn, patterned edges can be visualized much easier with the enclosed samples.

Applicant respectfully requests that the amendments presented herein be entered and that favorable action on this application be accorded.

Respectfully submitted,


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MARKED-UP SET OF AMENDED CLAIMS
SERIAL NO. 09/344,479

1. A patterned synthetic sponge, which comprises:
a synthetic sponge formed from an open cell elastomeric material and bearing a pattern having ragged, torn edges, being at least about 0.5" in depth, ~~and having been created by a tearing action,~~ said patterned synthetic sponge simulating a natural sea sponge when creating faux paint finishes therewith.

21. A paint roller head for two-color faux finishes, which comprises:
a pair of elongated annular sponges both of which surmount an interior annular core, said sponges formed from elastomeric material, wherein said sponges are spaced-apart on said core, so that each said sponge is capable of being dipped into different colored paint for creating two-color faux finishes.